



22 SEP 2010

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Blakely Sokoloff Taylor & Zafman, LLP
1279 Oakmead Parkway
Sunnyvale, CA 94085-4040

In re Application of
LUCIANI, James
U.S. Application No. 09/786,529
PCT No.: PCT/US1999/019490 : DECISION ON PETITION
Int. Filing Date: 26 August 1999 : UNDER 37 CFR 1.137(a)
Priority Date: 26 August 1998 :
Attorney Docket No.: 082771.P332PCTUS :
For: NON-BROADCAST MULTIPLE ACCESS :
INVERSE NEXT HOP RESOLUTION :
PROTOCOL

This decision is issued in response to applicant's "Petition For Revival of an Application for Patent Abandoned Unavoidably under 37 CFR 1.137(a)" filed 23 June 2003. The petition fee has been submitted.

The petition is **DISMISSED** without prejudice and the application remains **ABANDONED**.

The above-identified application became abandoned for failure to submit an oath or declaration in a timely manner in reply to the Notice of Missing Requirements dated 13 April 2001, which set a period for reply of two (2) months. Accordingly, the above-entitled application became abandoned at midnight on 21 June 2001. A notice of abandonment was mailed on 28 May 2002.

On 23 June 2003, applicant filed the present "Petition For Revival of an Application for Patent Abandoned Unavoidably under 37 CFR 1.137(a)." A grantable petition pursuant to 37 CFR 1.137(a) must be accompanied by: (1) the required reply, unless previously filed; (2) the requisite petition fee; (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable; and (4) any terminal disclaimer (and fee as set forth in 1.20(d)) required pursuant to 37 CFR 1.137(c). Petitioner has satisfied items (1) and (2). Item (4) is not applicable.

As to item (3), petitioner has not provided an acceptable showing that the delay was unavoidable. Petitioner's statement has been reviewed, however, the explanation is insufficient to satisfy the stringent standards applied to "unavoidable" abandonments.

Specifically, unavoidable delay is present only where petitioner and those acting for petitioner take all actions necessary to continue the prosecution of an application, but through the intervention of unforeseen circumstances, a required action is not timely taken. The actions and circumstances described in this petition, however, do not reflect the "care or diligence that is generally used and observed by prudent and careful men in relation to their most important business." Ex parte Pratt, 1887 Dec. Comm'r Pat. 31 (Comm'r Pat. 1887).

Petitioner states that "it appears that the United States Patent and Trademark Office made a mistake in the mailing address of the Notification since at such time its records showed that the undersigned was no longer at such address." However, a review of the papers submitted on 23 February 2001 reveals that counsel failed to provide a correspondence address in a clear and identifiable manner. (See 37 CFR 1.33(a)) As stated in Manual of Patent Examining Procedure, section 711.03(c), where an application becomes abandoned as a consequence of a change of correspondence address (the Office action being mailed to the old, uncorrected address and failing to reach the applicant in sufficient time to permit a timely reply) an adequate showing of "unavoidable" delay will require a showing that due care was taken to adhere to the requirement for prompt notification in each concerned application of the change of address (see MPEP § 601.03), and must include an adequate showing that a timely notification of the change of address was filed in the application concerned, and in a manner reasonably calculated to call attention to the fact that it was a notification of a change of address. Absent a showing that a change of correspondence request was made in this particular application, it cannot be concluded that the abandonment of the present application was unavoidable.

A petition to revive an application under 37 CFR 1.137(a) cannot be granted where a petitioner has failed to meet his burden of establishing unavoidable delay within the meaning of 37 CFR 1.137(a) and 35 U.S.C. 133. Haines v. Quigg, 673 F. Supp. 314, 5 USPQ2d 1130 (N.D. Ind. 1987). Therefore, since applicant has not satisfied item (3) above, the granting of the petition under 37 CFR 1.137(a) for revival based on unavoidable delay would not be proper.

RECOMMENDATION

Applicant may wish to consider filing a petition to the Commissioner under 37 CFR 1.137(b) requesting that the application be revived. Any petition filed under 37 CFR 1.137(b) requesting that the application be revived must meet the criteria indicated 37 CFR 1.137.

If reconsideration of the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(a)." No additional fee is required.

Any further correspondence with respect to this matter may be filed electronically via EFS-Web selecting the document description "Petition for review and processing by the PCT

Legal Office" or by mail addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

Anthony
Anthony Smith
Attorney-Advisor
Office of PCT Legal Administration
Tel: (571) 272-3298